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In re Application of:
BAN, Ju Hyun, et al. :
U.S. Application No.: 10/561,351 :
PCT No.: PCT/KR2004/001854 :
International Filing Date: 23 July 2004 :
Priority Date: 24 July 2003 :
Attorney's Docket No.: 05-616-B :
For: METHOD FOR AUTOMATICALLY :
SETTING A FREQUENCY OF A :
BASE STATION IN A CDMA-2000 :
SYSTEM :

DECISION ON PETITION UNDER
37 CFR 1.47(a)

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(b) By Person Having Proprietary Interest To File Application On Behalf Of Inventor Who Refuses To Cooperate" filed 16 April 2007, treated herein under 37 CFR 1.47(a). Applicants have submitted the required petition fee.

BACKGROUND

On 22 July 2004, applicants filed international application PCT/KR2004/001854. The application claimed a priority date of 24 July 2003, and it designated the United States. On 03 February 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 24 January 2006.

On 19 December 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 12 September 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 was required.

On 16 April 2007, applicants filed a response to the Notification Of Missing Requirements (with required extension fee) which included a declaration executed by one of the two inventors, and the petition under 37 CFR 1.47(b) considered herein. The petition seeks

acceptance of the application without the signature of the non-signing inventor Sang Won SON, whom applicants assert has refused to execute the application.

DISCUSSION

The present petition was filed under 37 CFR 1.47(b). However, by its express terms, 37 CFR 1.47(b) applies only to circumstances where “all of the inventors refuse to execute an application for patent, or cannot be found after diligent effort.” Where at least one of the inventors has executed a declaration, as is the case here, the applicable regulation is 37 CFR 1.47(a). Accordingly, the present petition is treated herein under 37 CFR 1.47(a).

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Here, applicants have submitted the required petition fee, and the petition expressly states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicants here have filed a declaration executed by inventor Ju Hyun BAN, which contains an unsigned signature block for the non-signing inventor Sang Won SON. However, applicants have also submitted a separate declaration executed on behalf of the non-signing inventor by Robert J. Irvine, a representative of the purported assignee.¹ The submission of a declaration expressly executed on behalf of the non-signing inventor by a third party eliminates the presumption that the cooperating inventor, Ju Hyun BAN, signed the declaration on his own behalf and on behalf of the non-signing inventor, as required. Accordingly, the declaration submitted herein cannot be accepted in satisfaction of item (3), above. In order to satisfy this requirement, applicants must submit a newly executed declaration from the cooperating joint inventor which complies with 37 CFR 1.497 and which includes an un-signed signature block for the non-signing inventor. Based on the above, item (3) is not satisfied on the present record.

Regarding item (4), where it is asserted that an inventor has refused to execute the application papers, section 409.03(d) of the MPEP states that a “copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning

¹ By the terms of 37 CFR 1.47(a), only the other joint inventors may sign the declaration on behalf of the non-signing inventor. The assignee may only sign such a declaration where 37 CFR 1.47(b) applies, that is, where none of the joint inventors have executed the application; this is not the case here.

inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, applicants have provided first hand statements, with documentary support, confirming that the applicant has been requested to provide a signed declaration, that a copy of the complete application was provided to the inventor, and that the inventor expressly stated that he would not cooperate. This submission is accepted as showing that the non-signing inventor has refused to execute the application. Item (4) is therefore satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy item (3) of a grantable petition, as discussed above and in the MPEP, that is, a declaration in compliance with 37 CFR 1.497 that may be accepted as having been executed by the cooperating inventor on his behalf and on behalf of the non-signing inventor. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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